



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Potter *et al.*

Appl. No.: 09/808,124

Filed: March 15, 2001

For: **High Fidelity Reverse**

Transcriptases and Uses Thereof

Confirmation No.: 4601

Art Unit: 1637

Examiner: Strzelecka, T.

Atty. Docket: 0942.5030001/RWE/HCC

Fifth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. The numbering on this Fifth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Fourth Supplemental Information Disclosure Statement filed on April 10, 2003, in connection with the above-captioned application.

Applicant would like to bring to the Examiner's attention cited Office Actions (Documents AS39-AT40) from the following copending applications which are directed to related technical matter:

U.S. Patent Application No. 09/845,157, filed May 1, 2001.

The identification of these Office Actions is not to be construed as a waiver of secrecy as to the corresponding application now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited Office Actions during prosecution of this application.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed within three months of the date of filing of a national application other than a continued prosecution application (CPA), OR within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international

application, OR before the mailing date of a first Office Action on the merits OR before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.

- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ c. Attached is our PTO-2038 Credit Card Payment Form in the amount of \$ _____ in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date

of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Enclosed find our PTO-2038 Credit Card Payment Form in the amount of \$ _____ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:

- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:
- ☒ 7. Copies of the documents are submitted herewith.
- ☐ 8. Copies of the documents were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. _____, filed

_____, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

- ☐ 9. No copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Helene C. Carlson
Agent for Applicants
Registration No. 47,473

Date: May 3, 2004

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Washington, D.C. 20005-3934
(202) 371-2600

FORM PTO-1449

ATTY. DOCKET NO.
0942.5030001/RWE/HCCAPPLICATION NO.
09/808,124FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENTFIRST NAMED INVENTOR
*Potter et al.*FILING DATE
March 15, 2001ART UNIT
1637

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>38</u>	Blain, S.W. and Goff, S.P., "Nuclease Activities of Moloney Murine Leukemia Virus Reverse Transcriptase," <i>J. Biol. Chem.</i> 268:23585-23592, The American Society for Biochemistry and Molecular Biology, Inc. (1993)
	AS	<u>38</u>	Gerard, G.F., <i>et al.</i> , "Reverse Transcriptase. The Use of Cloned Moloney Murine Leukemia Virus Reverse Transcriptase to Synthesize DNA from RNA," <i>Mol. Biotechnol.</i> 8:61-77, Humana Press (1997)
	AT	<u>38</u>	Lawyer, F.C., <i>et al.</i> , "Isolation, Characterization, and Expression in <i>Escherichia coli</i> of the DNA Polymerase Gene from <i>Thermus aquaticus</i> ," <i>J. Biol. Chem.</i> 264:6427-6437, The American Society for Biochemistry and Molecular Biology, Inc. (1989)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	39	Stratagene, "Gene Characterization Kits," Stratagene Catalog, Stratagene, p. 39 (1988)
AS	39	Copy of Office Action for United States Patent Application No. 09/845,157, Smith <i>et al.</i> , filed May 1, 2001, dated July 12, 2002
AT	39	Copy of Office Action for United States Patent Application No. 09/845,157, Smith <i>et al.</i> , filed May 1, 2001, dated September 16, 2002

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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>40</u>	Copy of Office Action for United States Patent Application No. 09/845,157, Smith <i>et al.</i> , filed May 1, 2001, dated February 6, 2003
	AS	<u>40</u>	Copy of Office Action for United States Patent Application No. 09/845,157, Smith <i>et al.</i> , filed May 1, 2001, dated July 28, 2003
	AT	<u>40</u>	Copy of Office Action for United States Patent Application No. 09/845,157, Smith <i>et al.</i> , filed May 1, 2001, dated September 29, 2003

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.